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APPLICATION NO.	FILING DATE	LU	FIRST NAMED INVENTOR	P	ATTORNEY DOCKET NO.
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MM21/0806

TRIAL & TECHNOLOGY LAW GROUP
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KOZMA, EXAMINER

ART. UNIT	PAPER NUMBER
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#10

08/06/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	977400	Applicant(s)	Lu et al
Examiner	T. Korme	Group Art Unit	2832

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on April 12, 1999.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1 - 8 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1-8 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper _____ Interview Summary, PTO-413
- Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1-8, the phrase below the inner portion of said side wall creates a nonsequitur since "the inner portion" has no antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, wherein fulfilling the requirements of 35 USC 112, are rejected under 35 U.S.C. 102(b) as being anticipated by Renskers. Applicant does not positively recite a printed circuit board (PCB); applicant's package is not mounted on a printed circuit board. Therefore, since the board is not part of the combination, it is of no moment whether the package of Renskers is subsequently mounted on top of a board or the pins of Renskers go through the board. The phrase, "for 4 mounting onto the surface of a printed circuit board" does not mean that the package is mounted on a printed circuit board. The pins 38 can be mounted on top of a PCB or can extend through holes of PCB; the claims neither include nor exclude such as arrangement. Intended use has no patentable significance. Contrary to applicant's contention other than claim 8, no claim has "terminal pins molded within the side wall." Claims 1, 2, 5 and 7 have the "terminal pins molded within and extending from the bottom of said package." Renskers has molding material above member 60 and the molding material is part of the package

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and side wall since it extends above flange 28; see col. 4, lines 20-27. Further, applicant does not recite the "one end" of terminal pins below the bottom of the side wall". The claims merely define the pins as extending through a "bottom portion of the said side wall below the inner portion of said side wall." Pins 38, 40, 42 extends through the bottom portion of the side wall and they are below the inner portion, or flange 28 of the side wall at 38, 42. Even the bent back portion 42 (one end) of the terminal pins are below side wall portion 28.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, wherein fulfilling the requirements of 35 USC 112, are rejected under 35 U.S.C. 103(a) as being unpatentable over Renskers taken with Matsumura et al. Assuming arguendo that the encapsulant above 60 does not mold the terminals "within and extending from the botom of said package; in order to provide a firm anchor for the terminals of Renskers, it would have been obvious to mold the terminals 32 of Renskers in the package in the manner of Matsumura et al.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-35 of copending Application No. 906,952. Although the conflicting claims are not identical, they are not patentably distinct from each other because the standoffs recited in the copending application inherently have a larger height.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Kozma whose telephone number is (703) 308-1326. The examiner can normally be reached on Monday-Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Gellner, can be reached on (703) 3087-1721. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Kozma/dc
July 14, 1999



THOMAS J. KOZMA
PRIMARY EXAMINER
ART UNIT 2832